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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,665	11/07/2005	Donald W. Kufe	00530-108US1	6843
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EXAMINER				
KUDLA, JOSEPH S				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
07/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/518,665

**Applicant(s)**

KUFE ET AL.

**Examiner**

JOSEPH S. KUDLA

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Foreword***

1. Applicant's Response to the Election/Restriction correspondence, filed May 5, 2008, is acknowledged. Upon further review of the Election/Restriction correspondence, the Examiner has determined the Restriction to require further restriction. Group I, encompassing instant claims 1-29, comprises three distinct inventions (neurological, ischemia/reperfusion and inflammatory) linked together by instant claims 1-4, that if not further restricted would represent a serious burden to the Examiner. Below, the Applicant will find the Restriction/Election of Species required before examination of the Application can proceed.

***Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 5-16 and 27-29 (in part), drawn to a method of reducing or preventing oxidative stress-associated cell death in an individual having a neurological disorder by administering an N-phenyl-2-pyrimidine-amine.
  - II. Claims 17-24 and 27-29 (in part), drawn to a method of reducing or preventing oxidative stress-associated cell death in an individual having an ischemia/reperfusion injury by administering an N-phenyl-2-pyrimidine-amine.

III. Claims 25, 26, 28 (in part) and 29 (in part), drawn to a method of reducing or preventing oxidative stress-associated cell death in an individual having an inflammatory disorder by administering an N-phenyl-2-pyrimidine-amine.

Claims 1-4 link Inventions I-III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-4. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are not longer applicable. Please reference *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). Please also reference MPEP §801.01.

3. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: There is no special technical feature in the instant claim set.

The lack of unity as cited in the initial Restriction/Election of Species, filed February 7, 2008, stands.

Applicant is required to elect a group to be examined on the merits.

***Election of Species***

4. The Election of Species for the N-phenyl-2-pyrimidine-amine as cited in the initial Restriction/Election of Species, filed February 7, 2008, stands.

***Type of Disorder or Condition***

5. If Applicant elects Group I to be examined on the merits, Claims 5-16 are generic due to a plurality of the following disclosed patentably distinct species represented in the instant specification on page 4, lines 22-25. The disorders vary distinctly symptomatically. For example, the symptoms associated with a subject that has retinitis pigmentosa (e.g., tunnel vision, blindness, night vision) would vary distinctly from the symptoms associated with a subject that has Parkinson's disease (e.g. tremors, rigidity, bradykinesia, postural instability, etc.). Therefore, a subject that has retinitis pigmentosa would not necessarily have Parkinson's disease. Thus, an individual search is required of each individual disorder/disease. Applicant is required to elect a disease/disorder, like Alzheimer's disease, to which the elected invention will be examined on the merits as drawn to; as well as identifying those claims to which the elected disease/disorder is drawn.

Applicant is cautioned that the election of a species of compound which has not specifically been disclosed as filed may be determined to be New Matter.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that to be complete, the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not

patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Kudla whose telephone number is (571) 270-3288. The examiner can normally be reached on 9am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph S. Kudla/  
Examiner, Art Unit 1611  
July 14, 2008

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615